



UNITED STATES PATENT AND TRADEMARK OFFICE

MW
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,601	02/27/2002	Daniel Tsu-Fang Wang	VTN-0583	8603

27777 7590 02/24/2004

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
----------	--------------

3653

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,601

Applicant(s)

WANG ET AL.

Examiner

Michael Butler

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 19-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3653

DETAILED ACTION

Priority

1. Applicant's claim of priority to application 09/945859 filed 2/1/00 is made is acknowledged.

Drawings

2. New drawings will be required contingent upon allowance because the drawings were objected to by the draftsman/declared informal by the applicant.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There was no antecedent basis for varnish in the specification for varnishing the label.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3653

6. Claims 19-29 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has conjoined elements using “and/or” (claim 19 L 2) creating vague and indefinite language as to the scope of the claim protection sought-alternate embodiments or a devices capable of reconfiguration for single as well as plural openings. Appropriate correction is required. The claims have been otherwise examined on the merits presuming Boolean “OR.”

(Re: cl 19) Applicant has conjoined elements with “OR” leaving in questions which elements are nested together as subgroups.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 19, 21, 22, 24, 26-30, 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Hebron et al. which discloses:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription

Art Unit: 3653

product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (c2 L 1-33)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product (c5 L 52-c6 L 3)

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (c5 L 52-c6 L 3)

(Re: cl 24). wherein after said printing step the method further comprises the step of adhering said label onto said packaging (c5 L 52-67)

(Re: cl 26) wherein said label has a label identification means (c 15 L 5-24)

(re 27) wherein said packaging has a product machine readable code, and said method further comprises the step of checking said label identification means and said product machine readable code before said adhering step (c9 L 10-19)

(Re: cl 28) wherein said method further comprises the step of picking said prescription product in customary packaging from inventory and diverting it to a customized graphics printing system prior to said checking step (c5 L 52-c6 L 3)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (c5 L 52-c6 L 3)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing)out said customized graphics for said packaging for said prescription product (c2 L 1-33)

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means (c9 L 10-19)

(Re: cl 33). wherein each of said labels is for a particular ordered prescription product, and said system matches up said prescription product with said label (c 15 L 5-24)

(Re: cl 34) further comprising a quality check station (c9 L 10-19)

(Re: cl 35) further comprising a label applicator (c5 L 52-67).

9. Claims 19, 21, 22, 26-30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Charhut et al. '829 (per original issue patent 5208762) which discloses:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (c3 L 6-41)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product (c4 L 1-24)

Art Unit: 3653

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (c4 L 1-9)

(Re: cl 26) wherein said label has a label identification means (c 15 L 5-24)

(re 27) wherein said packaging has a product machine readable code, and said method further comprises the step of checking said label identification means and said product machine readable code before said adhering step (c4 L 10-24; H(c9 L 10-19)

(Re: cl 28) wherein said method further comprises the step of picking said prescription product in customary packaging from inventory and diverting it to a customized graphics printing system prior to said checking step (c4 L 34-c5 L 25)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (c4 L 1-9)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing)out said customized graphics for said packaging for said prescription product (c3 L 6-41).

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means (c4 L 10-24)

10. Claims 19, 20, 25 29, 30, and 32, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al. '957 which discloses:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product.(abstract)

(Re: cl 20). printing step entails printing said customized graphics on primary packaging for said prescription product (abstract)

(Re: cl 25) wherein the prescription product is a contact lens (abstract)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system (abstract)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing out said customized graphics for said packaging for said prescription product.

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means.

(Re: cl 33). wherein each of said labels is for a particular ordered prescription product, and said system matches up said prescription product with said label

Art Unit: 3653

(abstract).

11. Claims 19, 21, 22, 29, 30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum which discloses:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product (abstract)

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product. (c3 L 19-33)

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label (abstract)

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system c3 L 19-33)

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing out said customized graphics for said packaging for said prescription product (abstract)

(Re: cl 32. wherein said customized graphics is printed on a label, and each label has a unique identification means (fig 3).

12. Claims 19, 33, 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Charhut et al. which discloses:

(Re: cl 19) The method of producing customized packaging which houses at least one prescription product, wherein said packaging is customized by the individual doctor prescribing and/or said patient receiving said at least one prescription product comprising the steps of: receiving an order for at least one prescription product from said doctor or a refill order from said patient; and printing out customized graphics specified by said doctor or said patient for said package for at least one prescription product.

(Re: cl 20). printing step entails printing said customized graphics on primary packaging for said prescription product.

(Re: cl 21) printing step entails printing said customized graphics on secondary packaging for said prescription product.

(Re: cl 22,29,32) printing step entails printing said customized graphics onto a label.

(Re: cl 23, 31). further comprising the step of varnishing the label.

Art Unit: 3653

(Re: cl 24). wherein after said printing step the method further comprises the step of adhering said label onto said packaging.

(Re: cl 25) wherein the prescription product is a contact lens.

(Re: cl 26) wherein said label has a label identification means.

(re 27). wherein said packaging has a product machine readable code, and said method further comprises the step of checking said label identification means and said product machine readable code before said adhering step.

(Re: cl 28) wherein said method further comprises the step of picking said prescription product in customary packaging from inventory and diverting it to a customized graphics printing system prior to said checking step.

(Re: cl 29,32) wherein said printing step is performed by a customized graphics printing system.

(Re: cl 30) A customized graphics printing system for adding customized graphics to packaging for a prescription product comprising: a computer for receiving order information for a prescription product and for the customized graphics to be printed on the packaging for said prescription product; and a printer for printing out said customized graphics for said packaging for said prescription product.

(Re: cl 31). further comprising a varnishing application apparatus for applying varnish to said packaging.

(Re: cl 32. wherein said customized graphics is printed on a label, and each label)has a unique identification means.

(Re: cl 33). wherein each of said labels is for a particular ordered prescription product, and said system matches up said prescription product with said label.

(Re: cl 34) further comprising a quality check station.

(Re: cl 35) further comprising a label applicator.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 19, 21, 22, and 24-35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hebron et al. in view of Marino. Jr. et al. wherein Hebron et al.

discloses the elements previously discussed and Marino, Jr. et al. discloses and elements

not explicitly taught by Hebron et al. including:

Art Unit: 3653

(re : cl 23,31) apparatus and method for applying varnish to the label (c3 L 13-19).

It would have been obvious at the time of the invention for Hebron et al. to use a varnish applicator to varnish the labels to stabilize the coatings and printing as taught by Marino, Jr. et al. al. and come up with the instant invention.

15. Claims 19, 20, 23, 25 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. '957 in view of Marino. Jr. et al. wherein Martin et al. '957 discloses the elements previously discussed and Marino, Jr. et al. discloses and elements not explicitly taught by Martin et al. '957 including:

(re : cl 1) apparatus and method for applying varnish to the label (c3 L 13-19).

It would have been obvious at the time of the invention for Martin et al. '957 to use a varnish applicator to varnish the labels to stabilize the coatings and printing as taught by Marino, Jr. et al. al. and come up with the instant invention.

16. Claims 19, 21, 22, 25, 29, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum in view of Marino. Jr. et al. wherein Baum discloses the elements previously discussed and Marino, Jr. et al. discloses and elements not explicitly taught by Baum including:

(re : cl 1) apparatus and method for applying varnish to the label (c3 L 13-19).

It would have been obvious at the time of the invention for Baum to use a varnish applicator to varnish the labels to stabilize the coatings and printing as taught by Marino, Jr. et al. al. and come up with the instant invention.

Art Unit: 3653

Conclusion


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler

Michael E. Butler
Examiner


DONALD P. WALSH
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 3600